

TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: September 14, 2006

Opposition No. 91172879

Serial No. 78511967

BIG DOG HOLDINGS, INC. Big Dog
Holdings, Inc.

v.

PENEGRE, Juliette

PENEGRE, Juliette

13 RUE GANNERON
PARIS, FRANCE, 75018

HAROLD ROSS: LEGAL ASSISTANT

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), are available at www.uspto.gov/web/offices/dcom/ttab/.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and



11-16-2006

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depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as indicated below. In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Discovery period to open: 10/4/06

Discovery period to close: 4/2/07

30-day testimony period for party
in position of plaintiff to close: 7/1/07

30-day testimony period for party
in position of defendant to close: 8/30/07

15-day rebuttal testimony period
to close: 10/14/07

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

ESTTA Tracking number: **ESTTA99193**

Filing date: **09/13/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Big Dog Holdings, Inc.
Granted to Date of previous extension	09/13/2006
Address	121 Gray Avenue Santa Barbara, CA 93101 UNITED STATES

Attorney information	Kurt Koenig Koenig & Associates 226 E. Canon Perdido St., Suite M Santa Barbara, CA 93101 UNITED STATES Kurt@incip.com Phone:805-965-4400
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Applicant Information

Application No	78511967	Publication date	05/16/2006
Opposition Filing Date	09/13/2006	Opposition Period Ends	09/13/2006
Applicant	PENEGRE, Juliette 13 rue Ganneron Paris, 75018 FRANCE		

Goods/Services Affected by Opposition

<p>Class 018. All goods and services in the class are opposed, namely: Traveling trunks and suitcases; umbrellas; parasols and walking canes; whips and saddlery; bags, namely athletic, carry-on, overnight, duffel, tote, travel, shoulder, and garment bags for travel; backpacks; haversacks; rucksacks, valises, briefcases; handbags; luggage; non-motorized, collapsible luggage carts; document cases; waist packs, and athletic cases in the nature of athletic bags</p>
<p>Class 025. All goods and services in the class are opposed, namely: Clothing, namely petticoats, sports jackets, vests, jackets, coats, raincoats, overcoats, anoraks, waist coats, capes, cloaks, pullovers, cardigans, jersey, jerkins, jumpers, track suits, pants, trousers, slacks, leggings, sweaters, sweatshirts, sweat pants, blouses, bodysuits, dresses, skirts, T-shirts, tank tops, shorts, jeans, Bermudas, suits, socks, stoles, scarves, ties, gloves, belts, underwear, corsets and bathing suits, hats, caps, cap peaks, shoes, boots, sandals</p>

Attachments	BDog NOO.pdf (8 pages)(213553 bytes)
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Signature	/Kurt Koenig/
Name	Kurt Koenig
Date	09/13/2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 78/511,967
For the mark: BDOG
Filing Date: November 5, 2004
Publication Date: May 16, 2006

BIG DOG HOLDINGS, INC.,)	
)	
OPPOSER,)	
)	
v.)	Opposition No. _____
)	
JULIETTE PENEGRE)	
)	
APPLICANT.)	
)	

NOTICE OF OPPOSITION

In the matter of the application of JULIETTE PENEGRE, an individual citizen of France, having an address of 13 rue Ganneron, Paris 75018, France (hereinafter "Applicant"), for registration of the mark displayed in Application Serial No. 78/511,967 (hereinafter "Application"), Big Dog Holdings, Inc., a corporation organized and existing under the laws of Delaware, having an address of 121 Gray Avenue, Santa Barbara, California 93101 (hereinafter "Opposer"), believes it will be damaged by the registration of Applicant's mark and hereby opposes the same.

The Application was filed on November 5, 2004 seeking registration of the trademark BDOG ("Applicant's Mark"). Applicant's Mark was published for opposition in the *Official Gazette* dated May 16, 2006 and an extension of time to oppose was granted by the Trademark Trial and Appeal Board through September 13, 2006.

As grounds for the opposition, Opposer alleges the following:

1. Opposer is engaged in the business of manufacturing, selling, distributing, and promoting in interstate commerce a wide variety of goods and services spanning a multitude of classes.

2. Since at least as early as 1983, Opposer and its predecessors in interest have utilized a variety of highly distinctive word marks incorporating the phrases "BIG DOGS" and "BIG DOG" to promote Opposer's distinctive variety of consumer products which include clothing, sportswear, and a wide variety of other goods and services designed to appeal to adults, teenagers and children.

3. Opposer sells a wide range of products and services in its company-owned retail stores located throughout the United States. Opposer also sells its products through Opposer's nationally and internationally distributed mail order catalog, through its internet website at www.bigdogs.com, and through licensing.

4. Opposer is the owner of numerous trademark registrations and applications to for marks which incorporate the words "BIG DOGS," including the marks specifically identified in Paragraphs 5 through 16 herein ("Opposer's Marks").

5. Opposer is the owner of U.S. Trademark Registration No. 1,459,306 granted September 29, 1987 for the mark BIG DOGS in class 025 for use on "Clothing namely shorts, t-shirts, tops, shirts, ladies' tank shirts, jackets, underwear, pullover shirts, sweat shirts, sweat pants, and caps."

6. Opposer is the owner of U.S. Trademark Registration No. 1,986,729 granted July 16, 1996 for the mark RUN WITH THE BIG DOGS in class 25 for use on "T-shirts, jackets, woven shirts, sweatshirts, caps, infant rompers, girl's dresses and children's sweatshirts."

7. Opposer is the owner of U.S. Trademark Registration No. 2,048,686 granted April 1, 1997 for the mark IF YOU CAN'T RUN WITH THE BIG DOGS STAY ON THE PORCH in class 025 for use on "T-shirts, sweatshirts, nightshirts, and children's T-shirts."

8. Opposer is the owner of U.S. Trademark Registration No. 2,059,754 granted May 6, 1997 for the mark LITTLE BIG DOGS in class 025 for use on "children's clothing, namely, shorts, T-shirts, pants, overalls, sweatshirts, sweat pants, sweat jackets, caps, rompers, onesies, shirts, volley shorts, underwear, socks, jumpsuits, diaper covers in the nature of legless, snap-on covers, and girls' clothing, namely, dresses, jumpers and bloomer dresses."

9. Opposer is the owner of U.S. Trademark Registration No. 2,217,495 granted January 12, 1999 for the mark BIG BIG DOGS in class 025 for use on "shorts, T-shirts, shirts, caps, pants, jackets, coats, sweatpants, sweatshirts, tank tops and underwear."

10. Opposer is the owner of U.S. Trademark Registration No. 2,348,494 granted May 9, 2000 for the mark BIG DOGS & Design in class 025 for use in connection with "Men's, women's and children's clothing, namely shorts, t-shirts, tops, shirts, jackets, underwear, pullover shirts, sweatshirts, sweat pants, athletic suits, hats, caps, blouses, vests, sweaters, sports coats, raincoats, pants, jeans, leggings, overalls, jumpsuits, rompers, dresses, skirts, boxer shorts, belts, ties, suspenders, shoes and socks."

11. Opposer is the owner of U.S. Trademark Registration No. 2,746,763 granted August 5, 2003 for the mark BIG DOGS KIDS in class 25 for use on "Children and pre-teen clothing, namely, shorts, skorts, T-shirts, pants, overalls, sweatshirts, sweatpants, sweat jackets, caps, shirts, blouses, underwear, socks, jumpsuits, dresses, leggings, swimsuits, pajamas and coats."

12. Opposer is the owner of U.S. Trademark Registration No. 1,798,361 granted October 12, 1993 for the mark BIG DOG SPORTSWEAR in class 42 for use on "Mail order services and retail store services featuring clothing, jewelry, accessories, home furnishings and sporting goods."

13. Opposer is the owner of U.S. Trademark Registration No. 1,842,765 granted July 5, 1994 for the mark BIG DOGS in several classes, including Classes 18 and 24 for use on "backpacks, shoulder bags, courier bags, duffel bags, and fanny packs" in Class 18 and "beach towels and fabric banners" in Class 24.

14. Opposer is the owner of U.S. Trademark Registration No. 2,206,261 granted November 24, 1998 for the mark BIG DOG'S in several classes, including Classes 18 and 25 for use on goods and services which include "tote bags, beach bags, book bags, athletic bags, sports bags, handbags, purses, wallets, key cases, credit card cases, briefcases, satchels, garment bags for travel, travel bags, travel cases, luggage, and umbrellas" in Class 018 and "blouses, vests, sweaters, blazers, sports coats, coats, rain coats, suits, pants, jeans, leggings, bottoms, overalls, jumpsuits, rompers, dresses, skirts, sweat suits, jogging suits, snow suits, boxer shorts, sleepwear, socks, hosiery, tights, leotards, bodysuits, shoes, boots, sneakers, sandals, slippers, ties, gloves, mittens, belts, hats, visors, aprons, bandannas, swimwear, headbands, suspenders, robes, lingerie, and scarves" in class 25.

15. Opposer is the owner of U.S. Trademark Registration No. 2,705,708 granted April 15, 2003 for the mark BIG DOG'S in class 35 for use on "on-line retail store services featuring clothing, accessories, jewelry, home furnishings, toys, games, sporting goods, gifts and computer products."

16. Opposer is the owner of U.S. Trademark Registration No. 1,980,728 granted June 18, 1996 for the mark RUN WITH THE BIG DOGS in class 18 and other classes for use on "Pet collars and pet leashes in Class 18."

17. Each of Opposer's registrations identified in Paragraphs 5 through 16, herein, are valid and subsisting and are conclusive evidence of Opposer's exclusive right to use the marks in connection with the goods and services identified in each registration.

18. Opposer's Marks are valid and subsisting and are conclusive evidence of Opposer's exclusive right to use Opposer's Marks on the goods and services identified therewith throughout the United States.

19. Because Opposer's Marks are arbitrary and strong, Opposer is entitled to protection of its distinctive marks.

20. Opposer and its predecessors-in-interest have used Opposer's Marks exclusively and consistently in commerce at least as early as the dates of use noted in each respective registration, and long before any date upon which Applicant can rely.

21. Opposer has prominently and extensively marketed, advertised, and promoted its goods and services under Opposer's Marks throughout the United States utilizing various promotional and advertising media.

22. Opposer's Marks have been advertised and promoted to the public since at least as early as 1983 and in such a manner that Opposer has created a recognizable family of marks using the words "BIG DOG" as a brand.

23. By reason of Opposer's extensive investment and promotional efforts throughout the United States, the public has come to recognize Opposer's Marks as signifying Opposer as the exclusive source of Opposer's goods and services under Opposer's Marks.

24. As a result of such extensive use and promotion of Opposer's Marks, Opposer has built extensive and valuable goodwill in connection with its trademarks identified herein.

25. Notwithstanding Opposer's prior rights in and to Opposer's Marks, Applicant applied to register Applicant's Mark for use in connection with "Traveling trunks and suitcases; umbrellas; parasols and walking canes; whips and saddlery; bags, namely athletic, carry-on, overnight, duffel, tote, travel, shoulder, and garment bags for travel; backpacks; haversacks; rucksacks, valises, briefcases; handbags; luggage; non-motorized, collapsible luggage carts; document cases; waist packs, and athletic cases in the nature of athletic bags in Class 18 and Clothing, namely petticoats, sports jackets, vests, jackets, coats, raincoats, overcoats, anoraks, waist coats, capes, cloaks, pullovers, cardigans, jersey, jerkins, jumpers, track suits, pants, trousers, slacks, leggings, sweaters, sweatshirts, sweat pants, blouses, bodysuits, dresses, skirts, T-shirts, tank tops, shorts, jeans, Bermudas, suits, socks, stoles, scarves, ties, gloves, belts, underwear, corsets and bathing suits, hats, caps, cap peaks, shoes, boots, sandals in Class 25" ("Applicant's Goods").

26. Applicant's Mark was published for opposition in the *Official Gazette* dated May 16, 2006.

27. Opposer also uses the stock symbol "BDOG" for its publicly traded stock which is traded on the NASDAQ open market system. The symbol BDOG is a common law trademark for Opposer and is associated with the goods and services of Opposer. Opposer has established in the minds of the public a relationship between that symbol and Opposer's goods or services such that purchasers view BDOG as an acronym for Opposer and the goods or services provided thereby.

28. Any use by Applicant of Opposer's stock symbol will result in confusion of the general public.

29. Applicant has intentionally appropriated Opposer's Marks and NASDAQ® stock symbol.

30. Because (a) Applicant's Mark so resembles Opposer's Marks and NASDAQ® stock symbol, (b) Applicant's Goods are identical to and/or competitive with Opposer's goods and services and (c) the target consumers and end users of the parties' respective goods are identical, the consuming public is likely to believe Applicant's Goods are sponsored by or in some way related to Opposer and Opposer's goods and services.

31. Applicant's Mark so resembles Opposer's Marks that the registration and use of Applicant's Mark on Applicant's Goods is likely to cause confusion, mistake, or deception among consumers within the meaning of Section 2(d) of the Trademark Act, all to Opposer's damage.

32. Applicant's Mark is confusingly similar to Opposer's Marks and thus interferes with Opposer's use and registration of Opposer's Marks.

33. Opposer's Marks qualify for protection under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), as amended.

34. The Application is subject to the provisions of Section 43(c) of the Lanham Act, as amended.

35. Opposer believes the registration of Applicant's Mark will further damage Opposer in violation of Section 43(c) of the Lanham Act, as amended.

36. Applicant's appropriation of Opposer's Marks will likely cause confusion among the parties' related consumers and thus interferes with the use of Opposer's Marks.

WHEREFORE, Opposer believes it will be damaged by said registration and requests the Application be denied registration and that this Opposition be sustained. This Notice of Opposition is concurrently filed with the required filing fee of \$600 for two classes.

Respectfully submitted,

BIG DOG HOLDINGS, INC.

Dated: September 13, 2006

By: _____


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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted by electronic mail via ESSTA to the United States Patent and Trademark Office on the date shown below.

Dated: September 13, 2006


KURT KOENIG

United States Patent and Trademark Office
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